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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,046	02/13/2004	Matthew Lerner	5486-0164PUS1	3923
67321 7590 03/17/2008 BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 GATEHOUSE ROAD SUITE 100 EAST FALLS CHURCH, VA 22040-0747				
EXAMINER				
TSUL, WILSON W				
ART UNIT		PAPER NUMBER		
2178				
MAIL DATE		DELIVERY MODE		
03/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

***Advisory Action
Before the Filing of an Appeal Brief***

Application No.

10/777,046

Applicant(s)

LERNER ET AL.

Examiner

WILSON TSUI

Art Unit

2178

–The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED 16 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims will be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2,5-7,9,10,13,15,16,19 and 21-26.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: With respect to claim 7 and 22, the applicant argues that "understanding the active element of then active content 1202, for example, in this context should provide the Examiner with enough reasonable basis by which to construe the claims in a fashion that clearly distinguish over the prior art made of record". However, the examiner respectfully points out that although the specification may include particular limitations that distinguish over the prior art; the present rejection for claim 7 and 22 as explained in the previous office action is maintained because, as explained, the prior art in combination teaches the required limitations. Should the applicant require limitations present in specification to further distinguish the present claim limitations of 7 and 22 over the prior art, then the applicant is suggested to include those limitations in the claim language.

Secondly, the applicant argues that both of the schiit references '014 and '876 "are more focused upon the ability to simply remove, that is take out of context certain editorial notes or graphic embellishments, with these editorial notes or graphic embellishments to be later used for a separate, disconnected reassembly in another document or user interface construct; [and thus either] Schiit reference is not the focus of their instant claimed invention [and teaches away from the claimed invention]. However, this argument is not persuasive since as explained in the abstract of Schiit et al ('876, and similarly in '014), and also pointed out by the applicant, the layout relationship/context data is retained for clips, such that the layout relationship/context data is used for display/view when requested by the user. Thus, since as specified in the abstract of the current/pending application (10/777046), the current invention "gathers context information regarding the clip, and displays the clips with annotations to the user"; which is also a similar goal taught by Schiit (use of context information regarding a free ink annotation for display/view). Therefore, Schiit does not teach away from the current application, but rather instead, supports the use of gathering context data; and the applicant's argument is thus, not persuasive.